

Application No.: 10/575,765

In reply to Decision on Petition for Revival mailed May 16, 2006

Page 1 of 3

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant:** Duncan Hugh Barclay

**Serial No.:** 10/575,765

**PCT No.:** PCT/GB2004/003791

**Intl. Filing Date:** 06 September 2004

**Priority Date:** 04 September 2004

**Title:** SYSTEM AND METHOD FOR CREATING,  
MANAGING AND EXECUTING A MULTI-  
ELEMENT PROCESS FOR GENERATING  
A COMPLEX ENTITY

**Docket No.:** 22557-3014

**Certificate of Mailing/Transmittal**

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Janet Byrne

8-16-06  
Date

**RESPONSE TO DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(B)**

Dear Sir:

This letter is written as a response to the Decision On Petition For Revival Under 37 CFR 1.137(b) mailed on May 16, 2006, in the above-identified case. The petition was dismissed without prejudice. According to the Decision, "additional information is required for a grantable petition as there is a question whether the delay was unintentional." Petitioners here respectfully request reconsideration on the merits of this petition, and here include additional information required for a grantable petition.

By way of background, Petitioners are the inventors of the invention described in the above-identified PCT Application, which had a March 4, 2006, deadline for filing in the U.S. national phase. The petition and associated papers were filed on April 12, 2006. According to the Decision, a "proper reply in the form of the basic national fee and the above-

captioned application were provided. The petition fee for a small entity of \$750.00 was submitted. A terminal disclaimer is not required. However, item (3) of 37 CFR 1.137(b) is not yet satisfied."

Item (3) of 37 CFR 1.137(b) relates to a showing that the entire delay was unintentional. Petitioners attempted to show that the entire delay was unintentional, but the Decision required more information. More particularly, the Decision states that "The affidavits submitted with the petition indicate that counsel was specifically instructed by co-applicant and Managing Director of Proxim-IT, Joan Weibel not to enter the U.S. national stage . . . . It is noted that the position of Managing Director is one normally presumed to have the authority to sign on behalf of an organization in a foreign countries. . . . Nonetheless, paragraph 3 of the Barclay and Weibel affidavit states the '[d]ecisions relating to the PCT Application are to be made jointly.' However, petitioners have provided no documentary evidence (such as employment agreements, contracts, etc.) supporting this assertion. Moreover this is in direct contradiction of the actions taken by Ms. Weibel here."

Petitioners respond here with a clarification of the points made in the original Barclay and Weibel affidavit. Petitioners respectfully submit that the original affidavit overly emphasized the relationship of the inventors to the company Proxim-IT. Instead, as shown in the Affidavit of Barclay and Weibel submitted here that the present application and a related case have never, at any stage, been assigned from the inventors to Proxim-IT or its predecessors. Also, Proxim-IT or its Board have not been directly involved in the present application or the decision to enter the national phase of the PCT Application. Accordingly, Joan Weibel's role as Managing Director should have no bearing on her decision-making power to abandon or to prosecute the present application.

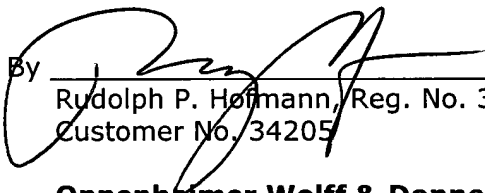
Instead, the present Affidavit sets out that the inventors themselves can direct prosecution and that all decisions require the input of all of the inventors. The present Affidavit sets out that under a verbal agreement between the inventors, the inventors are to provide input into any event regarding the PCT application. Also, the present Affidavit sets out all decisions on the prosecution of the related foreign application up to the decision to file in the national stage have been taken jointly by the inventors. Thus, Ms. Weibel's course of action was in contradiction with the verbal agreement between the inventors.

The decision not to enter the U.S. national phase was made without the input of both inventors due to a communication breakdown between them, and it was made on the basis of an incorrect assumption. Petitioners respectfully submit that the abandonment of the US

national phase application from the PCT application was unintentional. Accordingly, Petitioners respectfully request that that upon reconsideration of the merits of the petition filed on April 12, 2006, that the petition be granted.

No additional fees are believed to be due at this time. However, if we have miscalculated the Commissioner is authorized to charge our deposit account number 50-1901 for any fees that may be due. Any inquiry regarding this matter should be directed to Rudolph P. Hofmann at (612) 607-7340.

Respectfully submitted,

By   
Rudolph P. Hofmann, Reg. No. 38,187  
Customer No. 34205

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## **AFFIDAVIT OF DUNCAN HUGH BARCLAY AND JOAN WEIBEL**

**Further to our earlier Affidavit dated 31<sup>st</sup> March 2006, we, Duncan Hugh Barclay and Joan Weibel, declare and state the following further points:**

1. We are co-inventors of the subject matter of the reference PCT/GB2004/003791 (WO 2005/024684), hereinafter referred to as the "PCT Application. We are also the joint Applicants of the PCT Application.
2. The PCT Application claims priority from UK Patent Application 0320775.5 filed 4<sup>th</sup> September 2003 and UK Patent Application 0410389.1 filed 10<sup>th</sup> May 2004. The sole Applicant and inventor for both of these priority applications is Duncan Hugh Barclay.
3. The PCT application and two priority documents are hereinafter collectively referred to as the "Control Tower applications"
4. Duncan Barclay formed Electronic Press & News Limited in September 2003 in order to develop software solutions and tools relating to newsroom management. EPN later changed its name to Proxim-IT during 2004.
5. Duncan Barclay is the main investor, founder and Chairman of Proxim-IT. As Chairman of Proxim-IT, Duncan Barclay is not involved in the day-to-day running of the company but is largely responsible for the overall direction of the firm.
6. Joan Weibel is Managing Director of Proxim-IT and is responsible for day-to-day matters and the implementation of matters arising from Duncan Barclay's overall input into the direction of the firm.
7. It is noted that EPN received and Proxim-IT currently receives the benefit of the Control Tower applications in that the exploitation of the intellectual property contained therein is part of the business plans of these two companies.
8. It is further noted, however, that the Control Tower applications have never, at any stage, been assigned from Duncan Barclay and Joan Weibel to either EPN or Proxim-IT.
9. The company and its Board members have not been directly involved in any of the Control Tower applications or the decision to enter the regional/national phase from the PCT Application.
10. As Joint Applicants and co-inventors of the PCT Application, we (Duncan Barclay and Joan Weibel) have been and are responsible in our capacity as individuals, i.e. separate from our positions in Proxim-IT, for all decisions relating to the Control Tower applications.
11. All patent decisions, up to the decision to enter the national phase from the international phase of the PCT Application, have been taken jointly by Duncan Barclay and Joan Weibel.

12. Furthermore, given the ownership and history behind the Control Tower applications it was always the intention that we (Duncan Barclay and Joan Weibel) would both be required to provide input into any event regarding the PCT Application or the other Control Tower Applications. This agreement exists verbally between us.

13. During the period leading up to the US national phase deadline of 4<sup>th</sup> March 2006, Duncan Barclay was out of the UK for significant periods and was in the process of visiting a number of various business concerns in a variety of countries. During this time, Joan Weibel experienced difficulties in communicating with Duncan Barclay regarding the patent planning process relating to the PCT Application.

14. As a consequence of the difficulties discussed in the above point Joan Weibel took a decision regarding the filing of national phase patent applications from the PCT Application without the input of Duncan Barclay. This course of action was in contradiction with the unwritten understanding between Duncan Barclay and Joan Weibel but was taken due to the difficulties in discussing the matter with Duncan Barclay and because Joan Weibel was unaware of any particular exploitation possibilities with respect to the PCT Application. The financial implications of official and attorney's fees on entering the US phase was also a factor in Joan Weibel's decision.

15. On the basis of the factors noted in paragraph 14 above, Joan Weibel assumed that the PCT Application should not enter the US national phase.

16. It was however known to Duncan Barclay that there was interest in US based companies in the PCT Application invention and it was his intention to enter the US national phase from the international phase of the PCT Application. Given the history of joint decisions between Duncan Barclay and Joan Weibel it was assumed that US national phase entry would occur automatically in the event that no specific discussion took place. The financial requirements of entering the US phase were not known to Duncan Barclay prior to the 30 month deadline of 4<sup>th</sup> March 2006.

17. The decision regarding the national phase applications was made without the input of both co-inventors of the PCT Application (due to a communication breakdown between the undersigned) and was made on the basis of an incorrect assumption. We therefore regard the abandonment of the US national phase application from the PCT Application to be unintentional.

18. This affidavit was received for signature on <sup>7<sup>TH</sup> AUGUST</sup> ~~enter date~~ 2006.

Date 7<sup>TH</sup> AUGUST 2006  
Signed \_\_\_\_\_

Duncan Hugh Barclay

Date 7<sup>TH</sup> AUGUST 2006  
Signed \_\_\_\_\_

Joan Weibel